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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,864	01/08/2002	Hiroaki Sato	000449.00010	6381
22907	7590	08/26/2005	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			NGUYEN, DUC M	
			ART UNIT	PAPER NUMBER
			2685	

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/038,864	Applicant(s) SATO, HIROAKI	
	Examiner Duc M. Nguyen	Art Unit 2685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 9-13, 19-22, 28-31, 37 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9-13, 19-22, 28-31, 37-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/19/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to applicant's response filed on 6/2/05. Claims 1-3, 9-13, 19-22, 28-31, 37-38 are now pending in the present application. **This action is made final.**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims **1-3, 11-13, 21-22, 30-31** are rejected 35 U.S.C. 103(a) as being unpatentable over **Vu (US 6,185,436)** in view of **Tayloe (US 5,987,325)**.

Regarding claim **1**, **Vu** discloses a mobile communication apparatus for communicating with a network selectively utilizing a plurality of IC units (SIM cards) which would include all the claimed limitations (see Abstract), comprising :

- a detector configured to detect each of IC units connect to the handset (see col. 3, line 15 – col. 4, line 5, wherein it is clear that the electrical contact from the SIM card insertion would trigger a detection);
- an activator (executing program) configured to activate at least one IC as claimed (see col. 3, line 63 - col. 4, line 6);
- a controller (processor) configured to inform the network of data in the activated IC unit (see col. 3, lines 56-60).

Although **Vu** is silent on deactivating a non-selected IC, it is noted that such deactivating of a non-selected IC is just a standard practice and is known in the art as disclosed by **Taylor** (see Fig. 3 and **col. 5, lines 41-63**), for preventing receiving calls on non-selected SIM. Since **Vu** and **Taylor** are analogous arts, it would have been obvious to one skilled in the art to incorporate the above teaching of **Taylor** to **Vu** for deactivating non-select IC as well, for deactivating a non-selected IC unit as claimed, for preventing the reception of unwanted calls associated with the non-selected IC units for cost saving (i.e, preventing undesired calls that incurs expensive roaming charges associated with non-selected SIM from being activated, executed and delivered to the user).

Regarding claim **2**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, **Vu** discloses two or more SIM cards can be activated concurrently in the handset (see col. 2, lines 18-20 and col. 5, lines 15-27).

Regarding claim **3**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, **Vu** discloses the initiate establishment as claimed (see col. 3, lines 56-63).

Regarding claims **11-13, 21-22, 30-31**, they are interpreted and rejected for the same reason as set forth in claims 1-3 above.

2. Claims **9-10, 19-20, 28-29, 37-38** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Vu** in view of **Taylor** and further in view of **Hirsch (US 6,085,08)**.

Regarding claims **9-10**, the claim is rejected for the same reason as set forth in claim 7 above. In addition, **Vu** discloses the SIM data comprising a table of PLMN ID or cell ID (see col. 5, lines 5-10 and col. 8, lines 15-35), which would obviously comprise a home location code so that the preferred home PLMN can be selected for cost saving (i.e, avoid roaming charge). However, **Vu** is silent on the country code. However, it is noted that such country code is a component of the GSM specification as disclosed by **Hirsch** (see col. 2, line 60 – 67). Therefore, it would have been obvious to one skilled in the art to combine the above teachings of **Vu** and **Hirsch** for providing a country code as claimed, so that a mobile station located in an overlap coverage area of two cells having different country codes would be able to select the cell providing the least cost, for cost saving such as avoid roaming charge.

Regarding claims **19-20, 28-29, 37-38**, they are interpreted and rejected for the same reason as set forth in claims 9-10 above.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 11, 21, 30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

5. Any response to this final action should be mailed to:

Box A.F.

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry)

(571)-273-7893 (for informal or draft communications).

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Hand-delivered responses should be brought to Customer Service Window,
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

Any inquiry concerning this communication or communications from the examiner
should be directed to Duc M. Nguyen whose telephone number is (571) 272-7893,
Monday-Thursday (9:00 AM - 5:00 PM).

Or to Edward Urban (Supervisor) whose telephone number is (571) 272-7899.

Duc M. Nguyen

Aug 8, 2005

A handwritten signature in black ink, appearing to read 'Duc M. Nguyen', written over the printed name.